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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,288	04/18/2001	Koichi Okuda	35.C15301	5455

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EXAMINER
SINGH, SATWANT K

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/836,288	OKUDA ET AL.
	Examiner	Art Unit	
	Satwant K. Singh	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2001*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-4, 7, 8, 10-14, 17-20, 23-26, 29, 36, 43, and 47 are rejected under 35

U.S.C. 102(e) as being anticipated by Ohtsuka (US 6,327,049).

3.   Regarding Claim 1, Ohtsuka discloses a print system for providing print service

for printing an electronic document in response to a print request including designation

of the electronic document to be printed, the print system comprising: judging means for

judging whether a type of the print request is a type that the print request is transferred

from a client apparatus (user terminal 5) to a server apparatus (template server 1) and

image data is transferred via a network (network 10) from the server apparatus to a

printer (laboratory system 2), or a type that the print request is directly transferred from

the client apparatus (user terminal 5) to the printer (laboratory system 2) (col. 6, lines

51-57); and computing means for computing a use fee of the print service in accordance

with the judged type of the print request (if the template specified by the user requires a

fee for use, a warning message notifying that the fee is charged for the template is

displayed) (col. 7, lines 41-50).

4.   Regarding Claim 2, Ohtsuka discloses a print system, wherein said computing means selects a use fee system of the print service in accordance with information on the judged type of the print request (if the template specified by the user requires a fee for use, a warning message notifying that the fee is charged for the template is displayed) (col. 7, lines 41-50).

5.   Regarding Claim 3, Ohtsuka discloses a print system, wherein the server apparatus has a function of managing the print service and the server apparatus includes said computing means (if the template specified by the user requires a fee for use, a warning message notifying that the fee is charged for the template is displayed) (col. 7, lines 41-50).

6.   Regarding Claim 4, Ohtsuka discloses a print system, wherein the server apparatus transmits registered image data (template is registered in the order receiving center 7) (col. 7, lines 9-14 to the printer in response to the print request from the client apparatus (order file having been generated is provided to the laboratory system 2 directly or via the order receiving center 7) (col. 7, lines 66-67 and col. 8, lines 1-8).

7.   Claims 7, 11, 17, and 23 are rejected for the same reason as claim 1.

8.   Claims 8, 12, 18, and 24 are rejected for the same reason as claim 2.

9.   Claims 10, 14, 20, and 26 are rejected for the same reason as claim 4.

10.   Regarding Claim 13, Ohtsuka discloses a print system, wherein the server apparatus is connected to the client apparatus and the printer via the network (The laboratory system 2 and the template server 1 are connected by a network 10 such as

the Internet or a network using dedicated lines. It is preferable for the user terminal 5 to

be able to connect to the network 10 upon necessity) (col. 6,lines 50-57).

11.   Claims 19 and 25 are rejected for the same reason as Claim 13.

12.   Regarding Claim 29, Ohtsuka discloses a print system, for providing print service

for printing an electronic document in response to a print request including designation

of the electronic document to be printed, the print system comprising: managing means

(Fig. 4) (order file 6) for managing identification information for identifying a user

requesting the print service Table 2) (col. 10) and information on use records of the print

service used by the user (Table 3) (col. 11), both of the information being related to

each other (order file shown in FIG. 4 has a structure wherein a stream describing

properties of the order file, a stream describing information regarding an orderer, and at

least one order information storage describing the order information are stored under a

root storage (col. 9, lines 47-54); and computing means for computing a use fee of the

print service in accordance with the information on the use records of the print service

used by the user managed by said managing means (the usage of these data may be

limited by information showing consent to a charge for using the template or by a credit

card number for charging a fee) (col. 13, lines 31-35).

13.   Claims 36, 43, and 47 are rejected for the same reason as claim 29.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 5, 6, 15, 16, 21, 22, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtsuka in view of Chan et al. (US 6, 378,070).

16.   Regarding Claim 5, Ohtsuka fails to teach a print system, wherein said computing means computes the use fee in accordance with a print result notice from the printer.

Chan et al teaches a print system, wherein said computing means computes the use fee in accordance with a print result notice from the printer (there are three main areas where users could be billed, which are for: submission of an encrypted document to the document store 130, storage by the document store 130 of a document for a specified time; and transmission and successful printing of the document. Other acts, such as using the directory server 120, could potentially also be billed) (col. 5, lines 35-42)

Therefore, it would have been obvious to one of ordinary; skill in the art at the time of the invention to combine the teachings of Ohtsuka with the teaching of Chan to charge fees in accordance with the print services being used.

17.   Regarding Claim 6, Ohtsuka fails to teach a print system, wherein a fee system for the type that the print request is transferred from the client apparatus to the server apparatus and the image data is transferred via the network from the server apparatus to a printer is different from a fee system for the type that the print request is directly transferred from the client apparatus to the printer.

Chan et al teaches a print system, wherein a fee system for the type that the print

request is transferred from the client apparatus to the server apparatus and the image

data is transferred via the network from the server apparatus to a printer is different

from a fee system for the type that the print request is directly transferred from the client

apparatus to the printer there are three main areas where users could be billed, which

are for: submission of an encrypted document to the document store 130, storage by

the document store 130 of a document for a specified time; and transmission and

successful printing of the document. Other acts, such as using the directory server 120,

could potentially also be billed) (col. 5, lines 35-42)

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the teachings of Ohtsuka with the teaching of Chan to

charge fees in accordance with the print services being used.

18.   Claims 9, 16, 22, and 28 are rejected for the same reason as claim 6.

19.   Claims 15, 21, and 27 are rejected for the same reason as claim 5.

20.   Claims 30-35, 37-42, 44-46, and 48-50 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Ohtsuka in view of Lacheze et al. (US 5,956,698).

21.   Regarding Claim 30, Ohtsuka fails to teach a print system, wherein said

computing means determines a discount rate of a base use fee of the print service in

accordance with the information on the use records of the print service used by the

user, and determines a settlement amount of the print service in accordance with the

determined discount rate.

Lacheze et al teach a print system, wherein said computing means determines a discount rate of a base use fee of the print service in accordance with the information on the use records of the print service used by the user (a billable benefit or discount may occur when a page copy number exceeds a given page count level), and determines a settlement amount of the print service in accordance with the determined discount rate (a customer who starts using a particular service on a relatively regular basis may be eligible for a different billing plan than another user who accesses the service on a relatively irregular basis) (col. 12, lines 1-15).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ohtsuka with the teaching of Lacheze to offer regular customers a volume discount rate for using the printing services on a regular basis.

22.   Regarding Claim 31, Ohtsuka fails to teach a print system, further comprising: discount information managing means for managing information on the discount rate of the base use fee of the print service to be applied to the user (information about either a billable benefit and/or an available program is stored in the mass memory 332 for future access by the client); and notifying means for notifying the user of an effect that the information on the discount rate of the base use fee of the print service was updated (the system 330 could notify the customer in advance of the possibility of exceeding the given page count), wherein said discount information managing means updates the information on the discount rate of the base use fee of the print service in accordance with information on the use records of the print service used by the user, and said

notifying means notifies the user of the effect that the information on the discount rate of

the base use fee of the print service was updated (information about either a billable

benefit and/or an available program is stored in the mass memory 332 for future access

by the client) (col. 12, lines 1–15).

Lacheze et al teach a print system, further comprising: discount information

managing means for managing information on the discount rate of the base use fee of

the print service to be applied to the user; and notifying means for notifying the user of

an effect that the information on the discount rate of the base use fee of the print service

was updated, wherein said discount information managing means updates the

information on the discount rate of the base use fee of the print service in accordance

with information on the use records of the print service used by the user, and said

notifying means notifies the user of the effect that the information on the discount rate of

the base use fee of the print service was updated.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the teachings of Ohtsuka with the teaching of Lacheze to

offer regular customers a volume discount rate for using the printing services on a

regular basis.

23.   Regarding Claim 32, Ohtsuka teaches a print system, wherein said managing

means includes a management table storing identification information for identifying the

user and information on the use records of the print service used by the user, both of

the information being related to each other (order file shown in FIG. 4 has a structure

wherein a stream describing properties of the order file, a stream describing information

regarding an orderer, and at least one order information storage describing the order

information are stored under a root storage (col. 9, lines 47-54).

Ohtsuka fails to teach a print system, wherein said managing means updates the

management table for the user in accordance with use of the print service by the user.

Lacheze et al teach a print system, wherein said managing means updates the

management table for the user in accordance with use of the print service by the user

(information about either a billable benefit and/or an available program is stored in the

mass memory 332 for future access by the client) (col. 12, lines 1-15).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the teachings of Ohtsuka with the teaching of Lacheze to

store the use records of regular customers for future access by the customer.

24.   Regarding Claim 33, Ohtsuka fails to teach a print system, further comprising

notifying means for notifying the user of an effect that the management table was

updated, wherein said managing means updates the management table for the user in

accordance with use of the print service by the user, and said notifying means notifies

the user of an effect that the management table was updated.

Lacheze et al teach a print system, further comprising notifying means for

notifying the user of an effect that the management table was updated, wherein said

managing means updates the management table for the user in accordance with use of

the print service by the user, and said notifying means notifies the user of an effect that

the management table was updated (the system accesses the information stored with

the process of FIG. 6 (see step 416) and transmits the same, via step 428, to the

customer) (col. 12, lines 25-43).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the teachings of Ohtsuka with the teaching of Lacheze to

store the use records of regular customers to notify them of their usage of the print

system.

25.   Regarding Claim 34, Ohtsuka fails to teach a print system, further comprising

condition determining means for determining a charge condition applied to the user, in

accordance with the information on the use records of the print service used by the

user.

Lacheze et al teach a print system, further comprising condition determining

means for determining a charge condition applied to the user, in accordance with the

information on the use records of the print service used by the user (in response to the

GetBill call, an invoice, based on the accounting information stored in the account log

file 334, is generated at step 442) (col. 13, lines 1-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the teachings of Ohtsuka with the teaching of Lacheze to

issue a bill or invoice for print services rendered to the customer.

26.   Regarding Claim 35, Ohtsuka fails to teach a print system, further comprising:

condition managing means for managing identification information for identifying the

user and information on a charge condition applied to the user, both of the information

being related to each other; and notifying means for notifying the user of an effect that

the charge condition applied to the user was updated, wherein said condition determining means updates information on the charge condition applied to the user in accordance with use of the print service by the user and said notifying means notifies the user of the effect that the charge condition applied to the user was updated.

Lacheze et al teach a print system, further comprising: condition managing means for managing identification information for identifying the user and information on a charge condition applied to the user, both of the information being related to each other in response to the GetBill call, an invoice, based on the accounting information stored in the account log file 334, is generated at step 442) (col. 13, lines 1-10); and notifying means for notifying the user of an effect that the charge condition applied to the user was updated (the invoice generated with step 442 is, at step 450, transmitted to the customer) (col. 13, lines 11-36), wherein said condition determining means updates information on the charge condition applied to the user in accordance with use of the print service by the user and said notifying means notifies the user of the effect that the charge condition applied to the user was updated (provide the accounting system of FIGS. 1 and 2 with update information at appropriate intervals)(co. 13, lines 49-62).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ohtsuka with the teaching of Lacheze to have updated customer invoice information.

27.   Claim 37 is rejected for the same reason as claim 30.

28.   Claims 38, 44, and 48 are rejected for the same reason as claim 31.

29.   Claim 39 is rejected for the same reason as claim 32.

30.   Claims 40, 45, and 49 are rejected for the same reason as claim 33.

31.   Claim 41 is rejected for the same reason as claim 34.

32.   Claims 42, 46, and 50 are rejected for the same reason as claim 35.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Satwant K. Singh whose telephone number is (703)

306-3430. The examiner can normally be reached on Monday thru Friday 8am -

4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Satwant K. Singh
Examiner
Art Unit 2626

sks

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER